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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1788				
NOTIFICATION DATE		DELIVERY MODE		
10/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/743,864

Applicant(s)

NOJIRI, HIDEYUKI

Examiner

ANISH DESAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-61 is/are pending in the application.
- 4a) Of the above claim(s) 41, 42, 48, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39, 40, 43-47, 49-54 and 57-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments in response to the Office action mailed on 02/04/10 have been fully considered.
2. Support for amended claims is found in the specification. Given that the double eyelid forming device of claimed invention is used for creating a "fold" on skin of an eyelid, it is clear that the double eyelid forming article of presently claimed invention would intrinsically "lift" the skin of the eyelid in order to make a fold. Accordingly, replacing claim language "break" with "lift" does not add new matter.
3. 112 second paragraph rejections are withdrawn in view of applicant's amendment and response.
4. In view of applicant's response, the Examiner is withdrawing 112-first paragraph rejection with respect following language in claims 39, 45, and 51: "...break the skin of the eyelid from a surface of an eyeball" (claims 39, 45, 51), "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the tape member [or the string member] from being detached from adhering portions on the skin on the eyelid when...to form the double eyelid" (claims 39 and 45), and "the adhering portion of the adhesive layer has an adhesiveness sufficient to prevent elongate member from being detached from adhering portions on skin on the eyelid when...to form the double eyelid" (claim 51). However, the 112-first paragraph rejections with respect to claim language of the resilient shrinkability of the tape member (or string member) smaller than a resilient shrinkability of the skin on the eyelid are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 39, 40, 43-47, 49-54, and 57-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

6. With respect to claims 39, 45, and 51, said claims recite "...and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the tape member [or string member or elongate member]" (claims 39, 45, 51), it is submitted that specification fails to provide support for the aforementioned claim limitations.

7. On page 13 of 08/03/10 amendment, applicant has stated "Accordingly, the skin is necessarily stretched to be in the folded state. If the resilient shrinkability of the skin on the eyelid were *greater* than that of the tape member, then as discussed below, the skin would wrinkle instead of staying in the folded state and the claimed invention would

not work for its intended purpose. Therefore, it is respectfully submitted that the original specification supports the tape, string, or elongate member having a resilient shrinkability that is smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the tape, string, or elongate member." In response, the Examiner respectfully submits following:

8. As to applicant's arguments that if the resilient shrinkability of the skin on the eyelid were greater than that of the tape member then the skin would wrinkle instead of folding, however, applicants argument is not understood given that the claim does in fact require that the resilient shrinkability of the skin on the eyelid to be greater than the resilient shrinkability of the tape member. It is noted that claim language recites "...wherein ***the tape member*** in the stretched state is configured to ***have resilient shrinkability...and smaller [i.e. resilient shrinkability of the tape member be smaller] than a resilient shrinkability of the skin on the eyelid***". In other words, ***the resilient shrinkability of the skin on the eyelid is greater than the resilient shrinkability of the tape member***. The Examiner suggests that applicant delete "...and smaller than a resilient shrinkability of the skin on the eyelid". Further, as support for the phrase, applicants point to page 2, lines 2-6, page 10, lines 18-25, and page 11, line 16-page 12, line 20. However, it is not clear how these portions of the specification provide support for the cited phrase.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 39, 40, 43, 44, 51-54, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835).**

10. It is noted that claims 39 and 51 recite "a double eyelid forming article of manufacture for forming a fold on an eyelid of a user", "configured to be adhered onto an eyelid in a stretched state along a longitudinal direction to form a double eyelid", and "the tape member in the stretched state is configured to have a resilient shrinkability larger than tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in the direction perpendicular to the longitudinal direction of the tape member...lift the skin of the eyelid from a surface of an eyeball to form the fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward the unstretched state", and "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the...to form the double eyelid". It is respectfully submitted that the aforementioned recitations are intended use of the article, while some of the recitations are functional, it is submitted

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that if a structure and composition of the prior art article is same as claimed by the applicant's article, then the prior art article is functionally capable of meeting the aforementioned recitations.

11. Based on the above, any reference disclosing a tape member that is resiliently stretchable (i.e. elastic) having "a first and second surface to elongate consistently along the entire longitudinal direction of the tape member while these surfaces are oppositely faced to each other", "the first surface and the second surface...pair of side edges that consistently elongate...the entire longitudinal direction of the tape member", "the individual side edges of the first surface and the second surface...forms in parallel to each other "long the whole longitudinal direction...when the tape member is in an unstretched state, cross sections of the first surface...uniform form along the whole longitudinal direction...when the tape member is in the unstretched state...the first surface and the second surface each have an adhesive layer...entirety of the first surface and the second surface, the tape member has a consistent...along the entire longitudinal direction", will read on the claims.

12. Hodgson discloses adhesive materials for use on animal bodies especially human bodies for surgical, dermatological or cosmetic use. The examples include surgical drapes, adhesive dressings, strips and sheets, and eyeliners (Column 2. lines 74-75, Column 3. lines 1-5). Additionally, according to Hodgson another preferred use of the present invention is in surgical drapes. These are large flexible sheets, which are

provided with a continuous layer of adhesive on at least a part only of one surface (column 7, lines 64-67). Further, at column 1 lines 25-30, Hodgson discloses "According to the present invention...a backing material having a pressure-sensitive adhesive on at least substantially the whole of the body-adhering portion of at least one surface of said backing material". This disclosure of applying the adhesive on at least one surface of the tape is interpreted as that adhesive layer can be applied on the both surfaces of the tape member, and it reads on the claim requirement of "at least one of the first surface or the second surface has an adhesive layer covering an entirety of the first surface or the second surface".

13. Additionally, the adhesive drape of Hodgson as shown in Figure 7 has a backing layer 2 having an adhesive coating 4 on the surface of the backing layer. Further, the adhesive 4 is covered by a protector 6 (column 10, lines 27-31). The backing layer 2 of Hodgson is preferably formed of a polyurethane film (column 8, lines 5-6). At column 5, lines 69-74, Hodgson discloses Estane 5701 and 5702 brand thermoplastic polyurethane films, which is a polyurethane elastomeric film as evidenced by US 2007/0066185A1 to Felipe (paragraph 0058). Further, Hodgson teaches a use of elastic backing material (column 10, lines 38-39). The elastic backing layer 2 of Hodgson having an adhesive coating 4 is equated to a resiliently stretchable elongate tape member.

14. The adhesive tape member of Hodgson, as shown in Figure 7 has "the a first surface and a second surface" that "elongate consistently along the entire longitudinal direction of the tape member while these surfaces are oppositely faced to each other" and "the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the tape member when the tape member is in an unstretched state". Additionally, if one were to examine the cross-section of the adhesive tape member of Hodgson as shown in Figure 7, it would read on "cross sections of the first surface...is in the unstretched state, the cross sections each have uniform form along the whole longitudinal direction...is in the unstretched state".

15. As to the claim requirement of "the elongate member includes a pair of holding portions configured to be held with fingers and arranged individually on a first end of the elongate member and a second end of the elongate member along the longitudinal direction", Hodgson teaches that the two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). Moreover, as to the claim requirement of "the elongate member includes an adhering portion", the claim does not explicitly exclude the adhering portion from being a part of the surfaces of the tape member, therefore a portion of the backing layer surface of Hodgson which is covered with an adhesive layer is equated to the "adhering portion".

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16. As to the claim limitations of "the tape member in the stretched state is configured to have a resilient shrinkability larger than tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in the direction perpendicular to the longitudinal direction of the tape member...lift the skin of the eyelid from a surface of an eyeball to form the fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward the unstretched state", and "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the...to form the double eyelid", the Examiner submits following:

17. It is reasonable to presume that the adhesive tape member of Hodgson has the aforementioned features including "resilient shrinkability" and sufficient width and a sufficient length for forming the fold because as set forth above the adhesive tape members of Hodgson and that of applicant have similar structure and composition. Further, since Hodgson is used on skin and to produce wrinkles, it would meet the claim recitation "an entirety of the adhesive layer has an adhesiveness sufficient to percent the...to form the double eyelid". Therefore, the aforementioned features would be present. The burden is shifted to applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594).

18. Moreover, as to the claim requirement of the arrangement of a release material on each of the adhesive layers on the first surface and the second surface. It is noted that Hodgson discloses of applying the adhesive on at least one surface of the backing

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(column 1 lines 25-31) and covering the adhesive layer with a silicone-coated release paper (column 6 lines 70-73 and column 7 lines 70-71).

19. Thus, it would have been obvious to provide an adhesive on the second surface of the backing and cover it with a release layer, motivated by the desire to protect the adhesive layer.

20. As to the claim requirement of the elongate member being a string member and "cross sections...arcuate shapes...unstretched state", it is noted that the invention of Hodgson is used in surgical drapes, suture strips...solid eye liners etc. (column 3 lines 1-5). Further, Hodgson discloses the size and the shape of the suture strips may of course be varied as desired (column 8 lines 44-53). Therefore, choosing a shape the tape member in the form of a string having outwardly protruding arcuate shapes involves routine skill in the art.

21. Claims 45, 46, 50, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clavin (US 4, 653, 483).

22. It is respectfully submitted that recitations "a double eyelid forming article of manufacture for forming a fold on an eyelid of a user", "configured to adhere to the eyelid in...to form a double eyelid", and "wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold

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in a direction perpendicular to the longitudinal direction of the string member...to lift the skin of the eyelid from a surface of an eyeball...recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid", and "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the unstretched state to form the double eyelid" are intended use of the claimed article.

While some of these recitations are functional in nature, it is respectfully submitted if a structure and composition of the prior art article is same as claimed by applicant's article, then the prior art article is capable of functioning the intended use as presently claimed.

23. Based on the above, any reference disclosing a string member that is resiliently stretchable (i.e. elastic) having "a first and second surface to elongate consistently along the entire longitudinal direction of the same member while these surfaces are oppositely faced to each other", "the first surface and the second surface...pair of side edges that consistently elongate...the entire longitudinal direction of the tape member", "the individual side edges of the first surface and the second surface...forms in parallel to each other" along the whole longitudinal direction...when the tape member is in an unstretched state, cross sections of the first surface...uniform form along the whole longitudinal direction...when the tape member is in the unstretched state...the first surface and the second surface each have an adhesive layer...entirety of the first

surface and the second surface, the tape member has a consistent...along the entire longitudinal direction", will read on the claims.

24. Calvin discloses an adhesive tape having a backing and a layer of adhesive on each side of the adhesive tape (see abstract, Figure 15 and column 5 lines 1-5). As to the claim requirement of "string member", it is noted that Applicant has generally recited "a string member" but not provided any dimension (e.g. diameter, length etc.) of a string member nor defined what is meant by "string member". It is noted that Calvin's tape is applied to an eyelid to retain a fold in the skin thereof (column 1 lines 10-15). Further, Calvin discloses that "According to the present invention, a very thin strip of double-sided adhesive tape 32 generally **less than 1 cm in width** and 4 cm in length is attached to the upper eyelid 10 (column 3 lines 50-55). This disclosure of Calvin reads on a string member as claimed.

25. Further, the backing film of Calvin is formed of polyethylene (see column 5 lines 39-45), which meets claim 60. The polyethylene backing of Calvin reads on the resiliently stretchable elongate string member as required by the presently claimed invention. As to the claim requirements of "first surface and the second surface...oppositely faced to each other", "the first surface and the second surface each have a pair of side edges...of the string member", "the individual side edges are each in liner forms in parallel to each other...in an unstretched state", "cross sections of the first surface...outwardly protruding arcuate shapes...when the string member is in the

unstretched state...the cross sections each have a uniform form along the whole...in the unstretched state", these limitations are disclosed in Figure 13 (e.g. arcuate shape of the cross section) and Figure 15 or obvious optimization to one of ordinary skill in the art, motivated by the desire to produce a string member that can suitably be applied to eyelids.

26. As to the claimed features of "wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the string member...to lift the skin of the eyelid from a surface of an eyeball...recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid", and "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the unstretched state to form the double eyelid", and "a first end of the string member and a second end of the string member...a part configured to be removed after the double eyelid is formed" (claim 50), it is reasonable to presume that said features are necessarily present in the string member of Clavin.

27. Support for said presumption is based on the fact that as stated above the string members of Clavin as set forth above and that of applicant are structurally and

compositionally equivalent. Therefore, said claimed features would be present. Additionally, as to the claim requirement of the "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the unstretched state to form the double eyelid", the Examiner submits that since Clavin's article is applied to an upper eyelid to retain a fold in the skin thereof (see Background of The Invention of Clavin), Clavin meets this limitation. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594).

28. As to the claim requirement of the release material in a consistent and integral form, it would have been obvious to provide a release material in consistent and integral form, motivated by the desire to protect the adhesive layers.

29. **Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calvin (US 4,653,483) as applied to claim 45 above, and further in view of Samuelsen et al. (WO 99/38929). US 6,482,491B1 to Samuelsen is relied upon for convenience.**

30. The invention of Clavin is previously disclosed. Clavin is silent as to teaching the individual release materials each include an arcuate groove along a surface of each of the adhesive layers.

31. However, Samuelsen discloses an article having a surface showing adhesive properties and a cover layer (release layer) for protecting the adhesive surface (abstract). Additionally, the release layer of Samuelsen has indentations in the forms of grooves, ridges, bulges, bumps etc. (column 2 lines 22-26 and column 4 lines 20-35). This disclosure of Samuelsen reads on the release material having an arcuate groove as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the release materials having arcuate groove, motivated by the desire to easily remove the release materials.

32. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clavin (US 4,653,483) as applied to claim 45 above, and further in view of Hodgson (US 3,645,835).

33. Clavin does not explicitly teach "a first end of string tape member and a second end of the string member...holding portions configured to be held with fingertips, and the holding portions have no adhesive property or have a suppressed adhesive property".

34. However, the invention of Hodgson is previously disclosed. Hodgson discloses that the two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). The uncoated areas on the backing layer of Hodgson reads on a holding portion as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide holding portion having no adhesive property such that the string member can be handled easily during its application to an eyelid by

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a user and such arrangement would prevent user accidentally touching the adhesive layer and potentially contaminating the adhesive.

35. Claims 59 and 61 are under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835) as applied to claims 39 and 51, and further in view of Berglund et al. (US 4,310,509).

36. Hodgson is silent as to teaching polyethylene. However, Berglund discloses a PSA having antimicrobial material in it. Further at column 4 lines 30-40; Berglund discloses that the homogeneous dispersion [i.e. adhesive] is coated onto various backings to form dressings, drapes, tapes, etc. The preferred backing material is polyethylene.

37. It is noted that Hodgson's invention is directed to PSA that are used in dressings, plasters, adhesive bandages etc. (column 1 lines 5-15). Hodgson is silent as to teaching polyethylene. Secondary reference of Berglund provides polyethylene that can be used in adhesive tapes, dressings etc.

38. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the polyethylene backing as taught by Berglund and used as a backing in the invention of Hodgson, because selecting a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness.

Response to Arguments

39. Applicant's arguments filed on 08/03/10 have been fully considered but they are not persuasive.

40. On pages 14-15 of the amendment with respect to 103(a) rejections based on Hodgson reference (US 3645835), applicant asserts "The double eyelid forming article forms a fold of the double eyelid through the following process...Incidentally, the skin of the eyelid is formed on a curved..."

41. In response, the Examiner respectfully submits that applicant's arguments are not commensurate in scope with the scope of the presently claimed invention. *Claims are not directed to a process of using or forming a fold on an eyelid; instead claims are directed to an article. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.*

42. Additionally, as to applicant's arguments against Hodgson by pointing to Figure 3 in applicant's response (see page 18) and column 7 lines 13-16 of Hodgson, and asserting that Hodgson's tape produces large number of wrinkles and does not form a fold in the direction perpendicular to the adhering direction (see pages 18-19 of the amendment), the Examiner respectfully disagrees for the following reasons:

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43. First it is noted that as set forth in this and in previous Office action (OA), the adhesive tape member of Hodgson is similar in structure and composition to the tape member of applicant's claimed invention (see page 6-9 of previous OA). Accordingly, Hodgson's tape member would intrinsically form fold. Second, applicant has not provided any factual evidence that would clearly show that the *tape of Hodgson* can not form a fold. While applicant has pointed to Figure 3 (note Figure 3 is not from Hodgson) in their response, contrary to applicant's assertion, Figure 3 shows "folds". A part of Figure 3 is reproduced below for convenience which clearly shows folds (see below). Accordingly, applicant's arguments are not found persuasive.



44. Additionally, as to applicant's arguments (see page 19 of the amendment) that Hodgson describes that the tape can be used as eye liners (see column 7 lines 13-16), and that eye liner is completely different product than the articles that forms a fold of the double eye lid, the Examiner respectfully submits following:

45. The Examiner is not relying on the eye liner of Hodgson to teach or suggest fold. As such, applicant's arguments are not commensurate in scope with the basis of the rejection.

46. As to applicant's arguments on pages 20-22 of the amendment against Clavin (US 4653483), the Examiner submits following:

47. With respect to applicant's argument that Clavin is silent with regards to first stretching the tape, and then allowing the resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the tape returns to its original size, the Examiner submits following: it appears that applicant's arguments are based on the assumption that applicant's claimed tape is in contact with the skin of the eyelid. However, claims as presently recited do not require that the double eyelid forming article is positively in contact with the skin of an eyelid. Additionally, the Examiner submits that Clavin's adhesive tape and applicant are formed of same material namely polyethylene (see column 5 lines 39-45). Therefore, the tape of Clavin is necessarily stretchable and has resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the tape returns to its original size.

48. As to applicant's arguments that while Clavin describes that the adhesive strip can be formed of polyethylene; there are many different types of polyethylene with different structural properties such that the adhesive strip of Clavin does not inherently have resilient shrinkability larger than a tension of the skin, the Examiner submits following: while applicants argue that not all polyethylene have resilient shrinkability, applicants have not provided any evidence to show that the polyethylene of Clavin

would not possess the resilient shrinkability as claimed. Given that Clavin's adhesive strip is formed of polyethylene (column 5 lines 39-45), it is clear that Clavin's tape has resilient shrinkability larger than a tension of the skin on the eyelid.

49. With respect to applicant's arguments (see page 21 of the amendment) that "Further, it is noted that increased force would be placed on the adhesive layer during shrinkage as compared the adhesive strip 32 of Clavin...Thus, there is no disclosure in Clavin that the adhesive strip 32 could hold onto the skin during the shrinking.", the Examiner notes that applicant's arguments are presented without any factual evidence on the record. As such, the arguments are not found persuasive.

50. Further, as to applicant's arguments on page 21 that a person of ordinary skill in the art reading Clavin would understand that it is necessary to stick the adhesive tape to the eyelid along the three-dimensional shape of the eyeball, thus a curve of at least a portion of the side edges is an indispensable requirement in Clavin and the tape with linear side edges entirely parallel to each other is not a part of the double eyelid forming product, the Examiner submits following: as set forth in this and in previous OA, there appears to be no teaching or suggestion in Clavin that at least a portion of the side edges **must** be curved. Further, in absence of unexpected results, providing a tape having linear side edges that are entirely parallel to each other would have been obvious modification recognized by one of ordinary skill in the art who is in possession

of Clavin given that Clavin and applicant's tape are applied generally in the same area (i.e. skin of eyelid). Accordingly, applicant's arguments are not found persuasive.

Conclusion

51. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

52. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 9:00AM-5:30PM.

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54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1788

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787